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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/739,448

12/18/2000

Jerome Dale Johnson

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/739,448	Applicant(s) JOHNSON ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 20-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 20-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 23 October 2006. Claims 1, 6-7, 11, 30, 39-40, have been amended. Claims 12-19 have been cancelled. Claims 1-11, 20-49 are currently pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 20-27, 30-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6, 067, 522 for substantially the same reasons given in the prior Office Action (paper number 04142006). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to include the recitation of

- “with plan requirements data,” in lines 4-5;
- “determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options, the user selected plan

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options being obtained from an input device of the computer system,” in lines 6-10.

As per these new limitations Lockwood and Warady teach a method for generating a customized proposal (Lockwood; column 6, lines 3-11) as analyzed and discussed in the previous Office Action (paper number 04142006), further comprising

the database having stored therein insurance plan products with plan requirements data (Lockwood; column 5, lines 37-48); Examiner interprets Lockwood’s teaching of “[t]he memory 23 stores program information and information on insurance policies and prices for various insurance companies, which are periodically up-dated from the terminals 4 of the various companies, and information on policy quotes and sales, which can be accessed periodically by the respective insurance company terminals ... [] ... to perform insurance quotation calculations in response to customer information received from any of the terminals, to send quotation data to the respective terminal” (Lockwood; column 5, lines 37-48) to necessarily include storing in the “memory” (reads on “database”) plan requirements data in order to produce the insurance quotation; and

determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options, the user selected plan options being obtained from an input device of the computer system (Lockwood; column 3, lines 9-48, column 5, lines 37-48, column 6, lines 3-4, 17-32), (Warady; Figure 7e, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 5).

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The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 04142006, section 7, pages 3-5), and incorporated herein.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 in the previous Office Action (paper number 04142006), and incorporated herein.

(B) Claim 6 has been amended to include the recitation of

- “further comprising a step of obtaining the user selected plan options from the input device of the computer system,” in lines 1-3.

As per these new limitations Lockwood and Warady teach a method as analyzed and discussed in the previous Office Action (paper number 04142006) and in claim 1 above,

further comprising a step of obtaining the user selected plan options from the input device of the computer system (Lockwood; column 3, lines 17-25, column 6, lines 3-4)..

The remainder of claim 6 is rejected for the same reasons given in the prior Office Action (paper number 04142006, section 7, page 6), and incorporated herein.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 in the previous Office Action (paper number 04142006), and incorporated herein.

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(C) Amended claim 11 differs from amended method claim 1 by reciting a “computer program product readable by a computer system ...” in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of amended claim 11 repeats the limitations of amended claim 1, and is therefore rejected for the same reasons given above for amended claim 1.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 in the previous Office Action (paper number 04142006), and incorporated herein.

(D) Amended claim 30 differs from amended method claim 1, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer. As such, the recited amended claim features are rejected for the same reasons given above for amended claim 1, and incorporated herein.

The remainder of amended claim 30 repeats the subject matter of amended claim 1, and is therefore rejected for the same reasons given above for amended claim 1.

(E) Claim 39 has been amended to include the recitation of

- “prompt the user to input,” in line 2.

As per these new limitations Lockwood and Warady teach a method as analyzed and discussed in the previous Office Action (paper number 04142006) and in claim 30 above,

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further comprising a step of prompt the user to input selected plan options (Lockwood; column 6, lines 2-13).

The remainder of claim 39 is rejected for the same reasons given in the prior Office Action (paper number 04142006, section 7, pages 9-10), and incorporated herein.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 in the previous Office Action (paper number 04142006), and incorporated herein.

(F) The amendments to claims 7, 40 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 04142006, section 7, pages 6, 9-10), and incorporated herein.

(G) Claims 2-5, 8-10, 20-27, 31-38, 41-47 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 04142006, section 7, pages 5-10), and incorporated herein.

4. Claims 28-29, 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 and Warady, U.S. Patent Number 6, 067, 522, as

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applied to claim 1 above, and further in view of Gamble, et al., U.S. Patent Number 6, 163, 770 for substantially the same reasons given in the prior Office Action (paper number 04142006).

Further reasons appear hereinbelow.

(A) Claims 28-29, 48-49 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 04142006, section 8, pages 10-12), and incorporated herein.

Response to Arguments

5. Applicant's arguments filed 23 October 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 23 October 2006.

(A) At pages 10-12 of the 23 October 2006 response Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added limitations of the amendment filed 23 October 2006, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Lockwood, Warady and Gamble, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 04142006), and incorporated herein. In particular, Examiner notes that the recited features of "determining if a particular insurance plan may be offered but is not currently

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available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options” are taught by the combination of applied references. Examiner interprets Warady’s teachings of “YOUR INSURANCE WILL BE DELAYED IF YOU ARE NOT IN ACTIVE EMPLOYMENT BECAUSE OF AN INJURY, SICKNESS, LEAVE OF ABSENCE OR TEMPORARY LAY-OFF ON THE DATE THAT INSURANCE WOULD OTHERWISE HAVE BECOME EFFECTIVE” (Lockwood, Figure 7e, lines 2-4) (emphasis added) to teach a form of “determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options.”

As per Applicant’s arguments in the paragraph bridging pages 10-11 of the response filed 23 October 2006 that “[n]othing in these sections or other parts of Warady ‘522 teach” limitations in claim 1 of “presenting a description of insurance plan options available to the customer on a display device of the computer system ... [...] ... the description of insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer,” Examiner respectfully disagrees. Examiner interprets Warady’s teachings of

“[t]he prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans [reads on “description of insurance plan options”] require evidence of insurability of an employee to be approved by the plan provider before [reads on “is not currently available”] the employee is eligible to receive the chosen benefit or level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider (e.g.,

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when the employee desires to receive an initial life insurance face amount over \$250,000 or to increase his or her life insurance election after initial enrollment, such as from 2 to 3 times salary) [reads on “description of insurance plan options”] (emphasis added) (Warady; column 5, line 65 to column 6, line 10)

to teach the argued limitations.

As per Applicant's arguments in paragraph 1 on page 11 of the response filed 23 October 2006 that “Warady’522 does not describe how to use this table in any form of determination, calculation, or manipulation at all,” Examiner respectfully notes that these are not claimed limitations.

As per Applicant's arguments in paragraph 1 on page 11 of the response filed 23 October 2006 that Warady’522 does not teach a display device, Examiner respectfully disagrees, noting that Warady teaches a computerized system for enrolling people in benefit systems, that includes “a CRT type display monitor” (Warady; Figure 6, column 3, lines 10-25, column 13, lines 26-28).

As such, it is unclear as to how or why Applicant's claimed limitations are not met by at least the aforementioned passages. Perhaps Applicant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As per Applicant's arguments in paragraph 2 on page 11 and the arguments on page 12 of the response filed 23 October 2006, these features have been discussed earlier in this action.

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Conclusion

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please

label "PROPOSED" or "DRAFT" on the front page of

the communication and do NOT sign the

communication.

After Final communications should be labeled "Box AF."

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

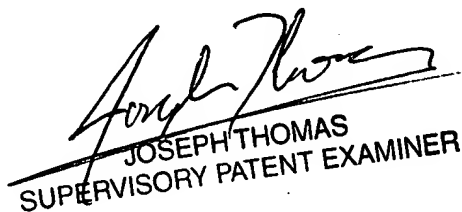
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

January 7, 2007



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER